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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/142,452 01/19/99 WACK

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IM52/0213  
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EXAMINER

MARKOFF, A

ART UNIT

PAPER NUMBER

1746

DATE MAILED:

02/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/142,452

Applicant(s)

WACK ET AL.

Examiner

Alexander Markoff

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2000 and 16 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 47-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 11/22/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/142,452 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Specification***

2. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

### ***Election/Restrictions***

3. It is noted that the instant claims are directed to two distinct inventions (method and composition), which can be properly restricted. The restriction requirement is not made this time because the same prior art can be applied to reject both of the inventions. The Applicants, however, advised that if the claims would be amended to require separate consideration and/or search the restriction requirement could be made.

### ***Response to Amendment***

4. The amendment filed 11/22/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material

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which is not supported by the original disclosure is as follows: the range for the amount of water in claims 47-65.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 47-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the range for amount of water, which is not supported by the original disclosure.

Claim 61 is also recites the compounds and the geniuses for the groups, which are not supported by the original disclosure.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 47-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are indefinite because it is not clear what is referenced as a temperature "that prevails during a cleaning process". What does it mean, "prevails"? Where this temperature "prevails"?

Claim 49 is also indefinite because "the step of undertaking cleaning" lacks proper antecedent basis.

Claim 50 is indefinite and incomplete because it lacks the step of forming the vapor, which should be condensed.

Claim 61 is also indefinite because it is not clear how can "-CH<sub>2</sub>-" be replaced by hydroxy, how can C<sub>2</sub> alkyl be branched, how can "-X-" be "-NR<sup>1</sup>", how can C<sub>2</sub> alkylene group comprise nonadjacent "-CH<sub>2</sub>-" groups, etc.

Claim 62 is indefinite because it is not clear what is referenced as "spontaneously evaporating". It is noted that the used term is relative in nature and lacks proper comparative basis, as well as the definition of where from this evaporating should not be spontaneous.

Claims 63 and 64 are indefinite because it is not clear whether or not "a further organic component" is different from "said organic component".

It is believed that most of the deficiencies of the claims were pointed out. However, the Applicants assistance is requested to place the claims in the format proper for the US patent practice.

***Claim Objections***

9. Claim 51 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim fails to further limit the previous claim because claim 50 recites an azeotropic composition, i.e. the composition in which the liquid and the vapor has the same composition.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 47, 48, 50, 51, 54, 55, 57, 58, 60 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 475,596.

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EPA 475,596 teaches (entire document, especially columns 4 and 5) a method for cleaning articles by contacting them with a liquid mixture of water with an organic compound or with a vapor of the mixture of water and the organic compound to remove contaminants from the article. The vapor is allowed to condense on the article. The mixture forms an azeotrope during the "liquid phase-to-vapor phase transition.

3. Claims 47-51 and 53-65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/28535.

WO 96/28535 teaches a method for cleaning articles comprising the same steps as claimed utilizing the composition as claimed. The reference teaches the specifically claimed chemicals as preferred ones. It is inherent that the same composition has the same properties.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28535.

WO 96/28535 teaches the same method as claimed except for the use of a filter.

However, the reference teaches purification and separation of the composition.

Filtration is one of the most common methods for purification and separation.

Accordingly, it would have been obvious to an ordinary artisan at the time the invention was made to incorporate filter for it's primary purpose in the method of WO 96/28535 with reasonable expectation of adequate results in order to use a conventional method and device for their conventional purpose.



### ***Response to Arguments***

15. Applicant's arguments filed 1/16/01 have been fully considered but they are not persuasive.

The Applicants state that the support for the newly introduced range of water is on page 6 of the specification.

The Examiner disagrees because the referenced part of the specification does not provide the support for the claimed range.

The Applicants argue that the cited references do not disclose the compositions having the proportions and the properties of the claimed compositions.

The Examiner disagrees. The applied references teach the claimed proportions for the component. Moreover, WO 96/28535 even recites all the specifically claimed chemicals as preferred. See, for example, recitation of dipropylene glycol mono n-propyl ether on page 11.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday - Friday 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-7719 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Alexander Markoff  
Primary Examiner  
Art Unit 1746

am  
February 12, 2001

**ALEXANDER MARKOFF  
PRIMARY EXAMINER**